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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/766,941

01/30/2004

Dietmar Janz

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EXAMINER

LAMB, BRENDA A

ART UNIT

PAPER NUMBER

1734

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
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3 MONTHS

01/23/2007

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 01/23/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com  
pto@gbpatent.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/766,941	<b>Applicant(s)</b> JANZ ET AL.	
	<b>Examiner</b> Brenda A. Lamb	<b>Art Unit</b> 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9,10,12-25 and 28-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14,15 and 18 is/are allowed.
- 6) ☒ Claim(s) 1-7,9,10,12-13,16-17,20-25 and 28-30 is/are rejected.
- 7) ☒ Claim(s) 19 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-6, 9-10,12-13 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Rempe et al.

Rempe et al teaches the design of a coating apparatus comprised the following elements: a nozzle assembly coupled to a reservoir or containment means (element 35), the nozzle assembly comprising a tip 39 having an outlet opening arranged to apply a coating material to the substrate; a device assembly which includes that delivers a

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substance to a region of the outlet opening, and the device comprising a tube whose tip is angled to correspond to a tapered portion of the tip of the nozzle, whereby the tip of the tube is arranged adjacent the tip of the nozzle, wherein a free end of the tip of the tube is positioned approximately generally level with the free end of the tip of the glue nozzle, and wherein the device is separate from the nozzle and delivers the substance behind the outlet opening relative to the direction. The Rempe et al apparatus is capable of applying a glue to a moving web since it teaches every claimed element of the apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Thus every structural element of the apparatus set forth in claim 1 is taught by Rempe et al. With respect to claim 2, Rempe et al apparatus is capable of applying a coating to a substrate within the scope of the claim since it teaches every claimed element of the apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 3, Rempe et al apparatus is capable of being arranged on

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a machine within the scope of the claim since it teaches every claimed element of the apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 4, Rempe et al apparatus is capable of applying a coating material within the scope of the claim since it teaches every claimed element of the apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). With respect to claim 5, Rempe et al teaches the device delivers the substance directly behind the outlet opening relative to the direction as shown in his Figure. With respect to claim 6, Rempe et al device is capable of delivering the substance in the form of spots. With respect to claim 9, Rempe et al device is arranged at a distance from the nozzle. With respect to claims 12-13, Rempe et al teaches a system for feeding the substance to the device includes valve 40' which regulates the amount of the coating applied which is applied to the moving web. With respect to claim 29, Rempe et al teaches a system for applying coating which is comprised of a nozzle comprising a tip

having an outlet opening; the nozzle being adapted to apply coating through the outlet opening, a feeding device that delivers a substance to a region of the outlet opening, the feeding device being a tube separate from the glue nozzle and whose tip is arranged adjacent the tip of the glue nozzle; the tip of the tube being angled to correspond to a tapered portion of the tip of the nozzle; a free end of the tip of the tube being positioned approximately generally level with a free end of the tip of the nozzle, and a system for feeding the substance to the feeding device. The Rempe et al apparatus is capable of applying substances within the scope of the claim since it teaches every claimed element of the apparatus. Note it has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex parte Masham, 2 USPQ 2d 1647 (1987). "[A]pparatus claims cover what a device is, not what a device does." Hewlett-Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Thus every structural element of the apparatus set forth in claim 47 is taught by Rempe et al. With respect to claim 10, Rempe et al shows the device is adjacent to and abuts the nozzle as shown in the Figure.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rempe et al.

Rempe et al is applied for the reasons noted above but fails to teach the tube is a capillary tube. However, Rempe et al teaches applicator element 39' is interchangeable with another having a different interior diameter so as to help control the volume flow

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rate of coating therefrom. Therefore, it would have been obvious to modify the Rempe et al apparatus by providing the tube with a small bore such that it reads on a capillary tube for the obvious advantage of enabling one to dispense minute amounts of coating to the substrate.

Claims 16-17, 21-24 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over McIntyre 4,725,468.

McIntyre '468 method of applying glue to a moving web utilizing a system that includes a glue nozzle coupled to a glue reservoir, the glue nozzle comprising a tip having an outlet opening arranged to apply glue to the moving web, and a device that delivers a substance to a region of the outlet opening, wherein the device is a tube as shown in Figure 2 whose tip assembly or head is arranged adjacent the tip of the glue nozzle, the method comprising: applying the glue onto the moving web while the moving web direction, feeding the substance behind the outlet opening relative to the direction; and at least one of controlling an amount of the substance which is applied to the moving web which includes metering pump 14'. McIntyre et al fails to teach the internal passage of the tube is smaller than the internal passage of the glue nozzle. However, it would have been prima facie obvious to modify the McIntyre et al process and apparatus by providing the tube with a smaller internal passage than the internal passage of the glue nozzle obviously dependent on end use requirements of the coated web and properties of the substance being applied to the web with McIntyre teaching his applicator can be used to apply a variety of substance or coatings to the web with the slightly smaller diameter tube enabling one more precise application of the

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substance to the web (see column 4 lines 3-12). Thus method of claim 16 is obvious over McIntyre '468. With respect to claims 21-22, McIntyre '468 shows in Figure 3 the upper layer substance is applied intermittently and cyclically on top of the lower layer dependent on the speed of travel of the moving web. With respect to claim 28, McIntyre '468 shows conveying the web away from the device or applicator. With respect to claims 23-24, McIntyre '468 teaches controlling the feeding on a timely basis (see column 2 lines 25-44). With respect to claim 17, the recitation that the substance comprises a low viscosity fluid does not define applicant's invention over McIntyre '468 since McIntyre '468 teaches his apparatus is capable of applying substance having a wide variety of viscosities and therefore it is capable of applying coating including those which have a low-viscosity compared to that dispensed from the glue nozzle.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over McIntyre 4,725,468 in view of McIntyre 3,595,204.

McIntyre '468 is applied for the reasons noted. McIntyre '468 fails to teach controlling the feeding on a quantity basis. However, it would have been obvious to control the quantity of the dispensed from the positive displacement metering pump in the McIntyre '468 process since McIntyre '204 teaches metering pumps enable one to dispense various quantity of the coating dependent on the rate of travel of the substrate.

Claims 16-17, 20-24 and 28-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over McIntyre 4,725,468 in view of Rempe et al.

Rempe et al is applied for the reasons noted above. Rempe et al teaches that his apparatus is used for applying a pattern of the substrate (see column 5 lines 2-12).



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Rempe et al teaches his apparatus is comprised of a nozzle having a tip with an outlet opening and a device which is a tube whose tip is arranged adjacent the tip of the nozzle. Rempe et al teaches the internal passage of the tube is smaller than the internal passage of the nozzle. Rempe et al teaches controlling the amount of the substance fed behind the outlet opening of the nozzle via means which includes valve 40'. Rempe et al fails to teach his nozzle applies glue onto a moving web while the web moves along a direction. However, it is known to apply glue pattern onto a moving web using applicators arranged adjacent one another by co-extrusion such as taught by McIntyre et al. Therefore, it would have been obvious to use the Rempe et al patterned coating applicator to practice the McIntyre process for the taught advantage of Rempe et al apparatus – enable one to precisely apply a pattern to a substrate and especially since Rempe et al teaches his applicator may used to apply a flowable material to a variety of substrates. Thus claim 16 is obvious over the above cited combination of references.

With respect to claims 21-22, Rempe et al apparatus is capable of intermittently feeding or cyclically feeding via valve 40' the substance behind the outlet opening relative to the direction. Therefore, it would have been obvious given the combination of McIntyre and Rempe et al as discussed above to intermittently feeding or cyclically feeding via Rempe et al valve 40' the substance behind the Rempe et al outlet opening relative to the direction in order to achieve the intermittent pattern of the substance as shown by McIntyre in Figure 3. With respect to claim 20, Rempe et al apparatus is capable of being continuously fed behind to the outlet via valve 41' and therefore obvious given the modified McIntyre process as discussed above to apply the substance in a manner set

forth dependent on end use requirements of the coated web. With respect to claim 17, the recitation that the substance comprises a low viscosity fluid does not define applicant's invention over McIntyre '468 process as modified since Rempe et al teaches his apparatus is capable of applying substance having a wide variety of viscosities and therefore it is capable of applying coating including those which have a low-viscosity compared to that dispensed from the glue nozzle. With respect to claims 21-22, McIntyre '468 shows in Figure 3 the upper layer substance is applied intermittently and cyclically on top of the lower layer dependent on the speed of travel of the moving web and Rempe et al is capable of being regulated such that the substance is applied intermittently and cyclically on top of the lower layer via valve 41'. With respect to claims 23-24, McIntyre '468 teaches controlling the feeding on a timely basis (see column 2 lines 25-44) and Rempe et al is capable of being regulated such that the substance is applied in such manner set forth in claims 23-24 via controller 50. With respect to claims 29-30, the same rejection applied to claims 16-17 is applied here. Further, as discussed above, Rempe et al teaches a system for applying coating which is comprised of a nozzle comprising a tip having an outlet opening; the nozzle being adapted to apply coating through the outlet opening, a feeding device that delivers a substance to a region of the outlet opening, the feeding device being a tube separate from the glue nozzle and whose tip is arranged adjacent the tip of the glue nozzle; the tip of the tube being angled to correspond to a tapered portion of the tip of the nozzle; a free end of the tip of the tube being positioned approximately generally level with a free end of the tip of the nozzle, and a system for feeding the substance to the feeding device. Rempe et al

teaches system is used to apply flowable materials to substrates in general (see column 1 lines 10-11). Rempe et al fails to teach his apparatus is used to apply glue and a substance to a moving web. However, it is known to apply glue pattern onto a moving web using applicators arranged adjacent one another by co-extrusion wherein the glue is applied onto the web and a substance is fed onto the substrate after or behind the outlet opening such as taught by McIntyre et al. Therefore, it would have been obvious to use the Rempe et al patterned coating applicator to practice the McIntyre process for the taught advantage of Rempe et al apparatus – enable one to precisely apply a pattern to a substrate and especially since Rempe et al teaches his applicator may used to apply a flowable material to a variety of substrates. As discussed above, the recitation that the substance comprises a low viscosity fluid does not define applicant's invention over McIntyre '468 process as modified since Rempe et al teaches his apparatus is capable of applying substance having a wide variety of viscosities and therefore it is capable of applying coating including those which have a low-viscosity compared to that dispensed from the glue nozzle. With respect to claim 28, McIntyre '468 shows conveying the web away from the device or applicator.

Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection.

Applicant's argument that McIntyre '468 fails to teach or suggest the method utilizes a system which includes a device which is a tube whose tip is arranged adjacent to the tip of the nozzle and has an internal passage which is much less than an internal passage of the glue nozzle is found to be non-persuasive since it is not commensurate

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in scope with claim language. Note claim 16 claims that the tube has an internal passage less than an internal passage of the glue nozzle which broadly reads on the tube having an internal passage which is only slightly less than the internal passage of the glue nozzle.

Claim 19 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 14-15 and 18 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brenda A. Lamb whose telephone number is (571) 272-1231. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday. The examiner can also be reached on alternate Wednesdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla, can be reached on (571)272-1187. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, reading "Brenda A Lamb". The signature is written in a cursive style with a large initial 'B' and a stylized 'L'.

Brenda A Lamb

Examiner

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